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1621 Barber Lane, MS D-106
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To: US PTO, Before Final

TC 2822

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REMARKS:

☐ Urgent☐ For your review☒ Reply ASAP☐ Please comment

Application Number: 10/643,687
Filing date: August 19, 2003
First named inventor: Sheldon Aronowitz et al.
Attorney docket number: 02-4828/1D

Transmitted herewith for filing via facsimile:

- Amendment in response to the Office Action dated August 6, 2004.

Pursuant to 37 C.F.R. 1.8, I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date indicated below:

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Connie del Castillo

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sheldon Aronowitz, et al.)
) Group Art Unit: 2822
)
) Examiner: Ida M. Soward
Serial No.: 10/643,687)
) Atty. Docket No.: 02-4828/1D
Filed: August 19, 2003)
)
For: High K Dielectric Gate Material)
Uniquely Formed)
)

RESPONSE TO OFFICIAL ACTION
Restriction/Election Requirement

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed April 30, 2003, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group II, claims 2-9. Please note, however, that Applicant requested deletion of claims 2-5 when filing this divisional application (see section 4, on page 2 of the divisional application transmittal).

Remarks/Arguments

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

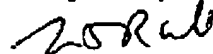
In searching the Group II claims, the class and subclass for the Group I claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

In light of the foregoing, applicants respectfully submit that a full and complete response to the Office Action is provided herein, and request that the application proceed to examination.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to deposit account 12-2252.

Respectfully Submitted,



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Date: August 13, 2003